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EXAMINER

KIM, CHONG HWA

ART UNIT	PAPER NUMBER
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3682

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 22

Application Number: 09/658,509  
Filing Date: September 08, 2000  
Appellant(s): THOMSON ET AL.

\_\_\_\_\_  
Paul Ditmyer  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed Oct 9, 2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1-4, 6-14, and 16-27 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

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5,165,301	Jeshurun et al.	11-1992
6,058,800	Giard	05-2000
5,509,328	Lai	04-1996

Copending US Patent Application 09/658,389 filed Sep. 8, 2000

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 6-14, and 16-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 15, 24, 27, 31, 33, 35, 38, 40, and 45 of copending Application No. 09/658,389. This rejection is set forth in prior Office Action, Paper No. 18.

Claims 1-4, 9, 10, 20-22, and 24-27 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 18.

Claims 1-4, 6-8, 11-14, and 16-19 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 18.

Claims 20, 22, and 23 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 18.

**(11) Response to Argument**

**A) Patentability under 35 U.S.C. 103**

In response to the Appellants argument that the “modification of the Giard’s clamping device to include a centered groove as taught by Jeshurun would render the Giard’s device unsatisfactory for its intended advantage because the use of a single centered fastener would be prevented” (as discussed on page 7, second paragraph of the Appeals Brief), the test for

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obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). It may appear that bodily incorporation of the centered groove of Jeshurun in the clamping device of Giard would require the fastener of Giard to be located somewhere else. However, it is the teaching of Jeshurun that a centered groove may be utilized in a clamping device such as Giard's in order to provide a more securing clamping device that limits relative lateral movements. It would be obvious to one of ordinary skill in the art to utilize the teaching of Jeshurun in the clamping device of Giard so that a centered groove may be formed in the clamp section 44 without over-extending to the fastener 56 of Giard in Figs. 8 and 9.

In response to the Appellants argument that the "modification of the Roddy clamping device to include a tubular hollow body having an opening in the handlebar clamping portion would render the Roddy device unsatisfactory for its intended advantage because the coverage and engagement of a greater surface area of the circumference of the handlebar would be impeded" (as discussed on page 9, 1<sup>st</sup> paragraph of the Appeals Brief), it is the Examiner's position that the modification of the Roddy clamping device with the opening as taught by Giard does not impede the intended advantage of Roddy. As discussed in column 2, lines 14-26, by Roddy, the Roddy's clamping device "covers about 91% of the circumference of the handlebar" while others "cover(s) less than 80%". One of the Roddy's intentions is to provide an engagement area that is greater than 80% of the surface area of the handlebar. (It is noted that

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Roddy does not mention that it must be 91% of the coverage in order to function as intended.)

It may appear that bodily incorporation of the opening as shown by Giard in the clamping device of Roddy would create a situation wherein less than 80% of the surface is covered by the clamping device. However, it is noted again, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). It would have been obvious for a person of ordinary skill in the art to modify the opening so that the clamping device would cover greater than 80% (or closer to 91%) of the engaging surface area of the handlebar. Such configuration would provide a greater engaging surface area and satisfy the intended advantage as stated by Roddy as well as achieve a lighter clamping device for bicycles which are especially adapted for racing.

In response to the Appellants argument that Giard “provides no indication of any advantages or need for the opening” and fails to “point to any teaching in the references to do so” (as discussed on page 9, 2<sup>nd</sup> and 3<sup>rd</sup> paragraphs of the Appeals Brief), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to modify the solid clamping device of Roddy with the clamping device having the hollow tubular

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shape with the opening as taught by Giard is found in the knowledge generally available to one of ordinary skill in the art. It is a common practice in the art of bicycles to reduce the weight of bicycles, especially for the highly competitive racers that rely heavily on the quality of their equipments wherein an ounce of difference can mean 1<sup>st</sup> and 2<sup>nd</sup> place. There are many different ways to reduce the weight; by modifying the materials, shapes, and sizes, etc. of the elements used in bicycles. One of the common ways is to use high strength alloy that is hollow and tubular so that the strength of the device is maintained if not increased and the weight is reduced so that the racers may finish quicker in a race that is highly competitive.

In response to the Appellants argument that Jeshurun fails to “include any drawings or detailed discussion of such a clamping device and merely teaches (col. 3, lines 17-21) that the clamp would include ‘a centered groove to accommodate the annular ridge’ of the handlebar” (as discussed on page 10, 1<sup>st</sup> paragraph of the Appeals Brief), it is the Examiner’s position that both the disclosure in the specification in column 3, lines 10-26 and the drawing as shown in Fig. 1 are sufficient enough to show that Jeshurun teaches the limitation as recited in claims 1, 11, and 20 concerning the recess for the enlarged diameter portion of the handlebar and the cavity in the recess extending fully over the arcuate extent. As shown in Fig. 1 of Jeshurun, there is an enlarged diameter portion 16 and 18 of the handlebar. A cavity (which is the centered groove mentioned in col. 3, line 18) is described in the specification. Furthermore, the specification, col. 3, lines 17-26, describes that the clamp attached to the stem (not shown) “grasp the cylindrical sections 16 and 18 to hold the steering member 10 in a centered mounted position”... “and then tighten(s) the clamp to hold the steering member in the position most ergonomically suitable to the rider.” One of ordinary skill in the art can glean from the above description that Jeshurun

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teaches at least a clamp device that clamps the enlarged diameter portions 16 and 18 of the handlebar with the annular ridge 14 that extends fully over the entire arcuate section. In order to clamp the portions 16 and 18, there must be a recess in the clamp portion that receives the enlarged diameter portions and a cavity that receives the ridge. Again, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

#### B) The Obvious-type Double Patenting Rejection

In response to the Appellant's argument that "claims of the present application are directed to the details of a handlebar clamping portion of the bicycle stem" and the claims of the co-pending application "are directed to the details of a steering tube clamping portion of a bicycle stem", the Examiner respectfully disagrees. Both applications disclose the same invention and both applications claim "A bicycle stem". The entire claims for both applications start with the limitation "A bicycle stem". One being adapted to be attached to the steering tube and the other being adapted to attach the handlebar does not mean that those bicycle stems are different. Claim limitations for both applications cross-over the metes and bounds of the handlebar clamping portion and the steering tube clamping portion in the bicycle stem providing the grounds for the obvious-type double patenting rejection.



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As to the argument concerning the cavity in the recess of the handlebar clamping portion, it is advised to review the discussion above under the section A) Patentability under 35 U.S.C. 103.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

chk  
December 23, 2003

Conferees

db

jl

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